

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed June 15, 2005. Through this response, claims 1, 8, 26, 32, 37 and 56 have been amended. Reconsideration and allowance of the Application and pending claims are respectfully requested.

I. Claim Objections

Claims 8, 26, 37 and 56 have been objected to because of the following informalities:

- a. Claim 8 recites “The system of claim *prior* 6...”. It should recite “The system of claim 6....”
- b. Claim 26 recites “... the user that purchased the recordable media content,” which lacks antecedent basis. There is no mention of purchasing recordable content within claims 1 or 25.
- c. Claim 37 is missing a period.
- d. Claim 56 recites “...the selected portable medium,” which lacks antecedent basis.

Office Action, p. 2.

In response to the objection, Applicants have amended claims 8, 26, 37 and 56. In view of the above-noted claim amendments, Applicants respectfully submit that the claims are not objectionable and respectfully request that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-13, 16-25, 27, 30, 32-42, 45-49 and 51-55 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Pub. No. 2004/0128685 to Hassell *et al.*, hereinafter referred to as *Hassell*. Applicants respectfully traverse this rejection on the grounds that *Hassell* does not disclose, teach, or suggest all of the claimed elements.

Applicants have amended claim 1, and thus the discussion below addresses the Office Action arguments in the context of the claim amendment.

B. Discussion of the Rejection

For a proper rejection of a claim under 35 U.S.C. § 102(e), the cited reference must disclose all elements, features, and steps of the claim. *See e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.* , 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988) (emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e). In the present case, not every feature of the claims is represented in the *Hassell* reference.

Independent Claim 1

Independent claim 1, as amended, recites:

1. A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
 - a memory for storing recordable media content characterizing information;
 - a storage device for storing a plurality of portable mediums; and
 - a processor configured with the memory to receive the recordable media content characterizing information into the memory, wherein the processor is further configured to provide a user interface for the recordable media content archiving system, *wherein the processor is further configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums.*

(Emphasis added.)

Independent claim 1 is allowable over *Hassell* for at least the reason that *Hassell* does not disclose, teach or suggest the features that are highlighted in independent claim 1 above. More specifically, *Hassell* does not disclose, teach or suggest that a processor is “configured to receive downloaded recordable media content characterizing information and downloaded recordable media content and to store the downloaded recordable media content into at least one of the portable mediums according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable mediums,” as recited in independent claim 1.

Hassell appears to teach user interaction with the programming guide of a set top box for the storage of television program and program information. At paragraph 8, *Hassell* recites:

The program guide implemented on the set-top box processes television program listings information and generates display screens (e.g., an interactive television program guide grid) for display, e.g., on a standard television monitor. **The user can interact with the television program guide by entering commands via a user input interface. ... The set-top box may store television programming and program information in a digital storage device associated with the program guide.**

(Emphasis added.)

Hassell further recites:

... the current invention gives the user **the ability to store information associated with recorded programs in a directory in the digital storage device** thereby providing easy access to program information. The program guide may also provide a global media library for indicating the programs stored on removable storage media used with the program guide.

Paragraph 9, lines 4-10.

As indicated above, *Hassell* appears to teach “a directory structure **containing information associated with stored entries.**” *Paragraph 20, lines 7-8. (Emphasis added.)* *Hassell* appears to allow for the recording of television programming along with storage of information associated with the recorded program. However, the teaching of

Hassell appears to reside with the operation of the programming guide. For example, “the program guide may also provide selectable listings of **programs currently stored** on digital storage device in any form of list, table or grid. The listings may be organized according to selectable organization criteria and sorted.” *Paragraph 37, lines 1-5.*

(Emphasis added.) While the listings may be organized and sorted according to selectable criteria, this appears to occur only after the program has been recorded, as evidenced by the repeated references to ‘**programs currently stored.**’ Further, *Hassell* also recites:

When the user indicates a desire to view the directory information for the **currently loaded storage medium**, the program guide obtains directory information from digital storage device 49 and generates a directory listing screen for display on monitor 45. … Directory listing screen 90 may indicate, for example, the volume name and available time left on the **currently loaded storage medium**.

Paragraph 56, lines 1-9. (Emphasis added.)

Thus, *Hassell* does appear to teach recording to a currently loaded storage medium. Finally, *Hassell* also appears to teach allowing “**the user to transfer programs** and **super-programs stored on digital storage device 49** to other volumes of digital storage device 49 or to secondary storage device 47....” *Paragraph 81, lines 1-4. (Emphasis added.)* Again, the teaching appears to be the transfer of programs **stored**, or already recorded.

Even if the storage device may be selected by the user in *Hassell*, and even if information about the program is stored along with the program, there is no matching or correlation by a processor between the program and the storage device. The program information itself is not used to determine the storage device or location. There is no discussion of receiving the “media content into at least one of the portable media according to a processor determined correlation of the downloaded recordable media content characterizing information and characterizing information corresponding to the at least one of the portable media.”

Applicants respectfully submit that storage of a program together with the program information is not the same as receiving and storing the media content according

to a correlation of the characterizing information of both the media content and the portable medium(s).

Applicants respectfully submit that since *Hassell* does not anticipate independent claim 1, as amended, claim 1 is in condition for allowance and the rejection should be withdrawn.

Further, Applicants respectfully submit that because independent claim 1 is allowable, as argued above, dependent claims 2-13, 16-25, 27 and 30 are allowable as a matter of law for at least the reason that they contain all the elements, features and limitations of independent claim 1. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

Independent Claim 32

Independent claim 32, as amended, recites:

32. A method for archiving recordable media content, comprising the step of:

providing a user interface for *enabling a user to request a recordable media content download from a remote device* for storage on at least one of a plurality of portable mediums located in a storage device, wherein *recordable media content characterizing information is correlated by a processor with at least one of a plurality of portable mediums based on portable medium characterizing information*, wherein the user interface further enables the user to categorize the recordable media content and the portable mediums into a structured archive; and receiving and storing recordable media content characterizing information into a memory.

(Emphasis added.)

Independent claim 32 is allowable over *Hassell* for at least the reason that *Hassell* does not disclose, teach or suggest the features that are highlighted in independent claim 32 above. More specifically, *Hassell* does not disclose, teach or suggest “enabling a user to request a recordable media content download from a remote device,” as recited in independent claim 32. Further, *Hassell* does not disclose, teach or suggest that

“recordable media content characterizing information is correlated by a processor with at least one of a plurality of portable mediums based on portable medium characterizing information.”

As argued above regarding claim 1, *Hassell* appears to teach user interaction with the programming guide of a set top box. Further, *Hassell* makes no mention of a user requesting a download from a remote device. Finally, there is no matching or correlation by a processor between the program and the storage device. The program information itself is not used to determine the storage device or location. There is no discussion disclosing, teaching or suggesting that the “recordable media content characterizing information is correlated by a processor with at least one of a plurality of portable mediums based on portable medium characterizing information.”

Applicants respectfully submit that since *Hassell* does not anticipate independent claim 32, as amended, claim 32 is in condition for allowance and the rejection should be withdrawn.

Further, Applicants respectfully submit that because independent claim 1 is allowable, as argued above, dependent claims 33-42, 45-49 and 51-55 are allowable as a matter of law for at least the reason that they contain all the elements, features and limitations of independent claim 32. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 14, 15, 28, 43 and 44

Claims 14, 15, 28, 43 and 44 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hassell* in view of International Publication No. WO 92/22983 to Browne *et al.*, hereinafter referred to as *Browne*. Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a

prima facie case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, Applicants respectfully submit that a *prima facie* case for obviousness has not been established.

Dependent Claims 14, 15, 28, 43 and 44

As described above, *Hassell* does not disclose the features of independent claim 1 or independent claim 32. Further, *Browne* does not remedy the above-described deficiencies. From the abstract, *Browne* recites an “audio/video recorder system [that] receives a plurality of transmission signals each containing program information and simultaneously stores the received transmission signals.” There is however, no mention of a user requesting a download from a remote device.

Thus, the proposed combination of *Hassell* in view of *Browne* fails to disclose, teach, or suggest the features of independent claims 1 and 32. Because claims 14, 15 and 28 contain the features of independent claim 1, and since dependent claim 43 and 44 contain the features of independent claim 32, Applicants respectfully submit that claims 14, 15, 28, 43 and 44 are allowable as a matter of law.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of

these claims is patentable over *Hassell* in view of *Browne* and that the rejection of these claims should be withdrawn.

C. Rejection of Claims 26 and 50

Claims 26 and 50 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hassell* in view of U.S. Patent No. 5,619,247 to *Russo*, hereinafter referred to as *Russo*. Applicants respectfully traverse this rejection.

As described above, *Hassell* does not disclose the features of independent claim 1 or independent claim 32. In that *Russo* does not remedy this deficiency of the *Hassell* reference, Applicants respectfully submit that claims 26 and 50, which depend from claim 1 and claim 32 respectively, are allowable over *Hassell* in view of *Russo* for at least the same reasons that claims 1 and 32 are allowable over *Hassell*.

In summary, it is Applicants' position that a *prima facie* for obviousness has not been made against Applicants' claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Hassell* in view of *Russo* and that the rejection of these claims should be withdrawn.

D. Rejection of Claim 31

Claim 31 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hassell*. Applicants respectfully traverse this rejection.

In the present case, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. With regard to the rejection using the *Hassell* reference, Applicants respectfully submit that since *Hassell* does not disclose, teach or suggest at least the emphasized claim features of independent claim 1, as argued above, then *Hassell* fails to disclose the same features contained in dependent claim 31.

It is also asserted in the Office Action that "it was notoriously known in this art at the time of Applicants' invention that systems can be located at the headend." *Office Action*, p. 11. According to MPEP § 2144.03:

It would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well

known are not capable of instant and unquestionable demonstration as being well-known.

MPEP § 2144.03 also states that:

If such notice is taken, the basis for such reasoning must be set forth explicitly. The Office Action must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge.

Accordingly, Applicants respectfully traverse the above conclusions and submits that the subject matter noted above should not be considered well known because the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required. Accordingly, Applicants submit that it has not been shown that the material asserted to be well known is capable of instant and unquestionable demonstration as being well-known. Thus, Applicants traverse the Examiner's use of official notice.

E. Rejection of Claims 29 and 56

Claims 29 and 56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Hassell* in view of U.S. Pat. No. 6,311,011 to *Kuroda*, hereinafter referred to as *Kuroda*. Applicants respectfully traverse this rejection.

As described above, *Hassell* does not disclose the features of independent claim 1 or independent claim 32. In that *Kuroda* does not remedy this deficiency of the *Hassell* reference, Applicants respectfully submit that claims 29 and 56, which depend from claim 1 and claim 32 respectively, are allowable over *Hassell* in view of *Kuroda* for at least the same reasons that claims 1 and 32 are allowable over *Hassell*.

Further, it is asserted in the Office Action that *Kuroda* discloses a "system in which the user is allowed to choose the medium to be utilized during recording." *Office Action*, p. 12. Specifically, *Kuroda* recites:

If the remaining capacity is insufficient at STEP S107, STEP S111 is executed. A dialogue of FIG. 6 warns that the storage device selected at STEP S106 does not have sufficient capacity for recording the contents and **allows the viewer a choice to select another storage device or to**

record the storage device at STEP S106 (STEP S111). If another storage device is selected, then STEP S112 follows STEP S111, or else STEP S108 follows STEP S111.

Column 5, lines 60-67. (Emphasis added.)

Even if the user is allowed to select another storage device for recording, this does not remedy the *Kuroda* deficiency. The media content will not be placed in a portable medium where the “recordable media content characterizing information is correlated by a processor with at least one of a plurality of portable mediums based on portable medium characterizing information.” It is further asserted in the Office Action that:

if user A always records cartoons on DVDs, user A could choose the DVD icon when directing the system to record cartoons. Therefore, the system would record cartoons on the “cartoon dvd....”

Office Action, p. 12.

Applicants respectfully disagree with this characterization. *Kuroda* discloses no teaching for a processor distinguishing between the portable recording media according to characterization information.

Thus, the proposed combination of *Hassell* in view of *Kuroda* fails to disclose, teach, or suggest the features of independent claims 1 and 32. Because claims 29 and 56 contain the features of independent claims 1 and 32 respectively, Applicants respectfully submit that claims 29 and 56 are allowable as a matter of law.

In summary, it is Applicants’ position that a *prima facie* for obviousness has not been made against Applicants’ claims. Therefore, it is respectfully submitted that each of these claims is patentable over *Hassell* in view of *Kuroda* and that the rejection of these claims should be withdrawn.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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